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UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
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ART UNIT	PAPER NUMBER
2157	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/10/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
Office Action Summary	09/599,675	HERRMANN ET AL.
	Examiner	Art Unit
	LaShonda T. Jacobs	2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>03 May 2006</u>.

2a) ☒ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>25-32,39-41,43-50,52-56,60 and 62</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>25-32,39-41,43-50,52-56,60 and 62</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____ .

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____ .

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

Response to Amendment

This is a Final Office action in response to Applicants' Amendment filed on May 3, 2006.

Claims 25, 39, 43, 48, 60 and 62 have been amended.   Claims 25-32, 39-41, 43-50, 52-56, 60

and 62 are presented for further examination.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims **25-32, 39-41, 43-50, 52-56, 60** and **62** are rejected under 35 U.S.C. 103(a) as

being unpatentable over Goldberg et al (hereinafter, "Goldberg" U.S. Pat. No. 5,823,879) in

view of Sgaraglino (U.S. Pub. No. 2003/0229893).

As per claim **25**, Goldberg discloses a system comprising:

*   a server communicatively coupled to client device and configured to communicate

    content to the client device for display to a user, (col. 14, lines 37-65; Goldberg

    discloses an Internet interface communicating with World Wide Web server in which

    the World Wide Web server access the database system for the determining the

    registration of a blackjack player. Once the user is registered, the World Wide Web

    server is able to communicate Internet responses to the blackjack player);

- wherein the content includes information relating to an interactivity and information relating to an advertisement, the interactive activity being separate from the advertisement (col. 16, lines 14-27 and col. 21, lines 363-63; Goldberg discloses a blackjack player receiving information related to a blackjack game or tournament and the blackjack player is able to receive advertisement information while playing the game).

However, Goldberg does not explicitly disclose:

- one or more software modules executing in an operating environment provided by the server and configured (a) to receive input from the client device, said input including, in a single transmission, information relating to the user's participation in the interactive activity and a request from the user to receiving additional information relating to the advertisement, and (b) after receiving said input, provide to the user additional information relating to the advertisement and to communicate content to the client relating to the interactive activity.

Sgaraglino discloses a system and method for providing information to a user in response to a user request comprising:

- one or more software modules executing in an operating environment provided by the server and configured (a) to receive input from the client device (abstract and paragraph 0028), said input including, in a single transmission, information relating to the user's participation in the interactive activity (paragraph 0045) and a request from the user to receiving additional information relating to the advertisement (paragraphs 0029 and 0033, Sgaraglino discloses a user requesting follow-up material for advertisement and

information relating to the current activity) (b) after receiving said input, provide to the user additional information relating to the advertisement and to communicate content to the client relating to the interactive activity (paragraphs 0029, 0033 and 0045).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Goldberg by implementing in a single transmission sending follow-up material relating to advertisements and information relating to the current activity in order to allow a user to request for advertising material without interrupting his or her current activity and it allows the user to express interest in the advertisements and receive the information without being directed to a new location thus reducing the time and effort cost of the user selecting the advertisement (Sgaraglino, paragraph 0115).

As per claim **26**, Goldberg further discloses:

- a registration database to store user information (col. 5, lines 16-25 and col. 22, lines 16-25).

As per claim **27**, Goldberg discloses:

- a web browser executing in an operating environment provided by the client device receive a request from the user to receive additional information relating to advertisement, (col. 4, lines 48-62, col. 25, lines 59-67 and col. 28, lines 10-12; Goldberg allows a user to participate in an interactive game and request additional information relating to an advertisement).

As per claim **28**, Goldberg discloses:

- wherein the media comprises a web-based computer game (abstract, col. 3, lines 57-65 and col. 5, lines 13-16).

As per claim **29**, Goldberg discloses the invention substantially as claimed discussed above. However, Goldberg does not explicitly disclose:

- wherein the content includes a check box and a server configured to communicate the advertising information to the user when the received input indicates a user has marked the check box.

Sgaraglino discloses a system and method for providing information to a user in response to a user request comprising:

- wherein the content includes a check box (push button) and a server configured to communicate the advertising information to the user when the received input indicates a user has marked the check box (paragraphs 0040-0041 and 0067; Sgaraglino discloses a user pushing a first button to display follow-up material regarding the advertisements and pushing a another results in the follow-up material being provided to the user via e-mail. Therefore, Sgaraglino discloses wherein the content includes a check box and a server configured to communicate the advertising information to the user when the received input indicates a user has marked the check box. Also, according to Applicant page 5, lines 6-8 of specification a user can submitting information by means of buttons, drop drown boxes, etc).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Goldberg by incorporating a push button to request follow-up material relating to advertisements in order to allow a user to express interest in the advertisements and receive the information without being directed to a new location thus

reducing the time and effort cost of the user selecting the advertisement (Sgaraglino, paragraph

0115).

As per claim **30**, Goldberg discloses:

- wherein the server is configured to store registration information for the user within the

  registration database prior to communicating the content to the client device (col. 5,

  lines 16-25 and col. 22, lines 16-25).

As per claim **31**, Goldberg discloses:

- wherein the server is configured to retrieve registration information from the registration

  database when sending the advertising information to the user (col. 21, lines 60-67 and

  col. 22, lines 1-25)

As per claim **32**, Goldberg discloses the invention substantially as claimed discussed above.

However, Goldberg does not explicitly disclose:

- wherein communicating the advertising information to the user includes sending an

  electronic mail message to the user.

Sgaraglino discloses a system and method for providing information to a user in response to

a user request comprising:

- wherein communicating the advertising information to the user includes sending an

  electronic mail message to the user (paragraphs 0029 and 0033).

Therefore it would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify Goldberg by sending an electronic mail message with follow-up

material relating to advertisements in order to communicate the follow-up material to the user

without interrupting his or her current activity thereby allowing the user to express interest in the

advertisements and receive the information without being directed to a new location thus

reducing the time and effort cost of the user selecting the advertisement (Sgaraglino, paragraph

0115).

As claims 39, 48 and 62, Goldberg discloses a method, software product stored on a

computer readable medium and system comprising:

- displaying a user interface on display permitting a user to participate in an interactive

  activity (abstract, col. 3, lines 57-67 and col. 4, line 1-8; Goldberg discloses a user

  playing a game (interactive activity));

- during the display of the user interface, displaying advertising information on the same

  display without interfering with the user's ability to participate in the interactive

  activity, the interactive activity being separate from the advertising information (col. 4,

  lines 48-62, col. 25, lines 59-67 and col. 28, lines 10-12; Goldberg allows a user to

  participate in an interactive game and request additional information relating to an

  advertisement);

- during the display of the user interface, receiving from the user a first signal indicating

  an interest in receiving additional information related to the advertisement information

  (col. 4, lines 48-62, col. 25, lines 59-67 and col. 28, lines 10-12; Goldberg allows a user

  to participate in an interactive game and request additional information relating to an

  advertisement); and

- causing said additional information related to the advertising information to be provided

  to the user in response to the first signal, without interfering with the user's ability to

  participate in the interactive activity (col. 4, lines 48-62, col. 25, lines 59-67 and col. 28,

lines 10-12; Goldberg allows a user to participate in an interactive game and request

additional information relating to an advertisement).

However, Goldberg does not explicitly disclose:

- wherein causing the additional information to be provided to the user comprises

   transmitting a second signal indicating the user's interest in receiving the additional

   information, the second signal being transmitted in response to the user's interaction.

Sgaraglino discloses a system and method for providing information to a user in response to

a user request comprising:

- wherein causing the additional information to be provided to the user comprises

   transmitting a second signal indicating the user's interest in receiving the additional

   information, the second signal being transmitted in response to the user's interaction

   (paragraphs 0040-0041 and 0067; Sgaraglino discloses a user pushing a first button to

   display follow-up material regarding the advertisements and pushing a another results in

   the follow-up material being provided to the user via e-mail. Therefore, Sgaraglino

   discloses wherein the content includes a check box and a server configured to

   communicate the advertising information to the user when the received input indicates a

   user has marked the check box. Also, according to Applicant page 5, lines 6-8 of

   specification a user can submitting information by means of buttons, drop drown boxes,

   etc).

Therefore it would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify Goldberg by incorporating a push button to request follow-up

material relating to advertisements in order to allow a user to express interest in the

advertisements and receive the information without being directed to a new location thus

reducing the time and effort cost of the user selecting the advertisement (Sgaraglino, paragraph

0115).

As per claim **60**, Goldberg discloses a method comprising:

- displaying information about an interactive activity to a user on a display associated

  with a client computer (abstract, col. 3, lines 57-67 and col. 4, line 1-8; Goldberg

  discloses a user playing a game (interactive activity)); and

- receiving at the client computer a request for advertising information and information

  related to the user's participation in the interactive activity, the interactive activity being

  separate from the advertising information (col. 16, lines 14-27 and col. 21, lines 363-63;

  Goldberg discloses a blackjack player receiving information related to a blackjack game

  or tournament and the blackjack player is able to receive advertisement information

  while playing the game).

However, Goldberg does not explicitly disclose:

- simultaneously transmitting to a server the user's request for advertising information and

  the information related to the user's participation in the interactive activity, wherein

  transmitting is performed in response to the user's interaction with the interactive

  activity.

Sgaraglino discloses a system and method for providing information to a user in response to

a user request comprising:

- simultaneously transmitting to a server the user's request for advertising information and

  the information related to the user's participation in the interactive activity, wherein

transmitting is performed in response to the user's interaction with the interactive

activity (paragraphs 0029, 0033 and 0045, Sgaraglino discloses a user requesting

follow-up material for advertisement and information relating to the current activity.

Therefore it would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify Goldberg by implementing in a single transmission sending

follow-up material relating to advertisements and information relating to the current activity in

order to allow a user to request for advertising material without interrupting his or her current

activity and it allows the user to express interest in the advertisements and receive the

information without being directed to a new location thus reducing the time and effort cost of the

user selecting the advertisement (Sgaraglino, paragraph 0115).

As per claims **40** and **49**, Goldberg discloses:

- wherein the interactive activity is a game, and wherein the advertising information is

  displayed during the game, the first signal is received from the user during the game,

  and said additional information is provided to the user without interrupting the game

  (col. 4, lines 48-62, col. 25, lines 59-67 and col. 28, lines 10-12; Goldberg allows a user

  to participate in an interactive game and request additional information relating to an

  advertisement).

As per claims **41** and **50**, Goldberg discloses the invention substantially as claims discussed

above.

However, Goldberg does not explicitly disclose:

- wherein the user interface is provided by a client computer connected over a network to

  a server computer, and wherein causing said additional information to be provided to the

user comprises transmitting from the client to the server a second signal indicating the

user's interest in receiving the additional information.

Sgaraglino discloses a system and method for providing information to a user in response to

a user request comprising:

- wherein the user interface is provided by a client computer connected over a network to

    a server computer, and wherein causing said additional information to be provided to the

    user comprises transmitting from the client to the server a second signal indicating the

    user's interest in receiving the additional information (paragraphs 0040-0041 and 0067;

    Sgaraglino discloses a user pushing a first button to display follow-up material

    regarding the advertisements and pushing a another results in the follow-up material

    being provided to the user via e-mail. Therefore, Sgaraglino discloses wherein the

    content includes a check box and a server configured to communicate the advertising

    information to the user when the received input indicates a user has marked the check

    box. Also, according to Applicant page 5, lines 6-8 of specification a user can

    submitting information by means of buttons, drop drown boxes, etc).

Therefore it would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify Goldberg by incorporating a push button to request follow-up

material relating to advertisements in order to allow a user to express interest in the

advertisements and receive the information without being directed to a new location thus

reducing the time and effort cost of the user selecting the advertisement (Sgaraglino, paragraph

0115).

As per claims **43** and **52**, Goldberg discloses the invention substantially as claims discussed above.

However, Goldberg does not explicitly disclose:

- wherein causing said additional information to be provided to the user includes causing an electronic mail message to be sent to the user.

Sgaraglino discloses a system and method for providing information to a user in response to a user request comprising:

- wherein causing said additional information to be provided to the user includes causing an electronic mail message to be sent to the user (paragraphs 0029 and 0033).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Goldberg by sending an electronic mail message with follow-up material relating to advertisements in order to communicate the follow-up material to the user without interrupting his or her current activity thereby allowing the user to express interest in the advertisements and receive the information without being directed to a new location thus reducing the time and effort cost of the user selecting the advertisement (Sgaraglino, paragraph 0115).

As per claims **44** and **53**, Goldberg discloses the invention substantially as claims discussed above.

However, Goldberg does not explicitly disclose:

- wherein the first signal is generated in response to the user checking a check box in the user interface.

Sgaraglino discloses a system and method for providing information to a user in response to a user request comprising:

- wherein the first signal is generated in response to the user checking a check box in the user interface (paragraphs 0040-0041 and 0067; Sgaraglino discloses a user pushing a first button to display follow-up material regarding the advertisements and pushing a another results in the follow-up material being provided to the user via e-mail. Therefore, Sgaraglino discloses wherein the content includes a check box and a server configured to communicate the advertising information to the user when the received input indicates a user has marked the check box. Also, according to Applicant page 5, lines 6-8 of specification a user can submitting information by means of buttons, drop drown boxes, etc).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Goldberg by incorporating a push button to request follow-up material relating to advertisements in order to allow a user to express interest in the advertisements and receive the information without being directed to a new location thus reducing the time and effort cost of the user selecting the advertisement (Sgaraglino, paragraph 0115).

As per claims **45** and **54**, Goldberg further discloses:

- including registering the user prior to displaying the user interface (col. 5, lines 16-25

and col. 22, lines 16-25).

As per claims **46** and **55**, Goldberg discloses:

- wherein causing said additional information related to the advertising information to be provided to the user in response to the first signal, without interrupting the user's ability to participate in the interactive activity, includes causing registration information for the user to be retrieved (col. 4, lines 48-62, col. 22, lines 16-27, col. 25, lines 59-67 and col. 28, lines 10-12; Goldberg allows a user to participate in an interactive game and request additional information relating to an advertisement).

As per claims **47** and **56**, Goldberg discloses:

- wherein causing said additional information related to the advertising information to be provided to the user in response to the first signal, without interrupting the user's ability to participate in the interactive activity (col. 4, lines 48-62, col. 25, lines 59-67 and col. 28, lines 10-12; Goldberg allows a user to participate in an interactive game and request additional information relating to an advertisement)

However, Goldberg does not explicitly disclose:

- capturing an email address of the user.

Sgaraglino discloses a system and method for providing information to a user in response to a user request comprising:

- capturing an email address of the user (paragraphs 0029 and 0033).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Goldberg by capturing an email address of the user to send an electronic mail message with follow-up material relating to advertisements in order to

communicate the follow-up material to the user without interrupting his or her current activity

thereby allowing the user to express interest in the advertisements and receive the information

without being directed to a new location thus reducing the time and effort cost of the user

selecting the advertisement (Sgaraglino, paragraph 0115).

Response to Arguments

5.   Applicant's arguments filed January 4, 2007 have been fully considered but they are not

persuasive.

The Office notes the following arguments:

a. Sgaraglino does not teach that the interactive activity is separate from the advertisement.

b. Sgaraglino fails to disclose or to suggest simultaneously transmitting to a server the user's

request for advertising information and the information related to the user's participation in the

interactive activity, where transmitting is performed in response to the user's interaction with the

interactive activity.

In response:

a. Applicants argue that Sgaraglino does not teach that the interactivity is separate from the

advertisement. However, the examiner disagrees. Sgaraglino was not relied upon to teach this

feature instead Goldberg was used. Goldberg discloses a blackjack player receiving information

related to a blackjack game or tournament and the blackjack player is able to receive

advertisement information while playing the game in which the advertisement is separate from

the blackjack game. The player is able to view the advertisement during the game without

interrupting his/her game (col. 16, lines 14-27, col. 21, lines 36-63, col. 25, lines 59-67 and col.

28, lines 10-16).

b. Applicants argue that Sgaraglino fails to disclose or to suggest simultaneously transmitting to

a server the user's request for advertising information and the information related to the user's

participation in the interactive activity, where transmitting is performed in response to the user's

interaction with the interactive activity. However, the Examiner disagrees. Sgaraglino discloses

a system and method for providing information to a user in response to a user request.

Sgaraglino also discloses a user pushing a first button to display follow-up material regarding the

advertisements and pushing another results in the follow-up material being provided to the user

via e-mail. The follow-up material regarding the advertisement is sent to the user email without

interrupting their current activity. Therefore, Sgaraglino discloses simultaneously transmitting to

a server the user's request for advertising information and the information related to the user's

participation in the interactive activity, where transmitting is performed in response to the user's

interaction with the interactive activity.

Conclusion

6.   Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

        A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to LaShonda T. Jacobs whose telephone number is 571-272-4004.

The examiner can normally be reached on 8:30 A.M.-5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ltj   LaShonda T Jacobs
March 26, 2007   Examiner
                                                                Art Unit 2157

ARIO ETIENNE
SUPERVISORY PATENT EXAMINER
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